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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,415	01/02/2001	Paul J. Rank	0007056-0054	3147

26263 7590 04/07/2004

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EXAMINER

VAUGHN, GREGORY J

ART UNIT PAPER NUMBER

2178

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,415

Applicant(s)

RANK, PAUL J.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application History

1. This action is responsive to the application filing, Application filed on 1/2/2001.
2. Claims 1-16 are pending in the case, claims 1 and 9 are independent claims.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- "230" on page 13, line 9.
- "350" on page 14, line 3.
- "450" on page 14, lines 15 and 17.
- "570" on page 15, lines 3 and 11.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. The disclosure is objected to because of the following informalities:

- The disclosure recites those reference signs listed in paragraph 3 above, which are not shown in the drawings.
- The disclosure recites: "*at step 220 the spreadsheet file is downloaded from the desktop to the PDA*" (page 13, lines 8-9). Step 220 of Figure 2 is directed toward "*Operate PDA*".
- The disclosure recites: "*at step 230 the user operates the spreadsheet application on the PDA*" (page 13, lines 9-10). Step 230 is not shown on Figure 2, but step 220 is directed toward "*Operate PDA*".
- The disclosure recites: "*the spreadsheet file is downloaded from the desktop to the PDA at step 340*" (page 14, lines 2-3). Step 340 of Figure 3 is directed toward "*Operate PDA*".
- The disclosure recites: "*at step 350 the user operates the spreadsheet application on the PDA*" (page 14, lines 3-4). Step 350 is not shown on Figure 3, but step 340 is directed toward "*Operate PDA*".
- The disclosure recites: "*at step 440 the user first downloads the spreadsheet file from the desktop to the PDA*" (page 14, lines 13-14). Step 440 of Figure 4 is directed toward "*Operate PDA*".
- The disclosure recites: "*operating the spreadsheet application on the PDA with the available functions at step 450*" (page 14, lines 14-15). Step 450 is not shown on Figure 4, but step 440 is directed toward "*Operate PDA*".

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- The disclosure recites: *"downloading the spreadsheet file from the desktop to the PDA at step 440"* (page 14, line 17). Step 440 of Figure 4 is directed toward *"Operate PDA"*.
- The disclosure recites: *"at step 570, the user operates the spreadsheet application on the PDA"* (page 15, lines 3-4). Step 570 is not shown in Figure 5, but step 560 is directed toward *"Operate PDA"*.
- The disclosure recites: *"downloading the spreadsheet file from the desktop to the PDA at step 560"* (page 15, lines 4-5). Step 560 is directed toward *"Operate PDA"*.
- The disclosure recites: *"the spreadsheet file is downloaded from the desktop to the PDA at step 560"* (page 15, line 10). Step 560 of Figure 5 is directed toward *"Operate PDA"*.
- The disclosure recites: *"at step 570, the user operates the spreadsheet application on the PDA"* (page 15, lines 10-11). Step 570 is not shown on Figure 5, but step 560 is directed toward *"Operate PDA"*.
- The disclosure recites: *"local server computer 923"* (page 19, line 23).

Reference sign 923 of Figure 9 is directed toward *"Host"*.

Appropriate correction is required.

6. The use of the following trademarks has been noted in this application:

- *"Motorola"* on page 21, line 16.
- *"Intel"* on page 21, line 16.
- *"Pentium"* on page 21, line 17.

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- "SPARC" on page 21, line 17.
- "Sun Microsystems" on page 21, line 17.

It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Objections

7. Claim 8 is objected to because of the following informalities: misspelling of said (shown as sadi) in the first line of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

9. Claims 1-3, 5, 6, 8, 9-11, 13, 14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Barile et al. US Patent 5,977,886 (filed 10/10/1997, patented 11/2/1999). "*Barile et al.*" is hereafter referred to as "*Barile*".

10. **Regarding independent claim 1**, Barile recites: *"the code is a member of a code set adaptively selected based on the application"* (column 2, lines 3-10). Barile discloses a PDA in Figure 1 (at reference sign 20). Barile further recites: *"A keycode set is identified at the data processing system, and a message identifying the identified keycode set is communicated from the data processing system to the user input device. In response to a keystroke, a keycode from a keycode set of the plurality of keycode sets stored at the user input device which is identified in the communicated message is communicated"* (column 3, lines 2-9).
11. **Regarding dependent claim 2**, Barile recites: *"This and other objects, features and advantages are provided according to the present invention by systems and methods for communicating a user input to an application resident on a data processing system, in which a user input accepted at a user input device is communicated using a code which is a member of a code set which is adaptively selected to optimize a performance parameter for communicating user inputs to the application"* (column 2, lines 3-10).
12. **Regarding dependent claim 3**, Barile recites: *"For example, a user input device may utilize keycodes for an English-text word processing application in a different fashion than for a word processing application in a different language or a specialized text processing application such as a computer program editor"* (column 2, lines 24-29). Compare *"family of functions"* with *"keycodes for an English-text word processing application"*.

13. **Regarding dependent claims 5 and 6**, Barile recites: *"However, the keyboard 10 and PDA 20 may be used for applications other than English-text word processing. For example, a spreadsheet application may be running on the PDA 20 which involves more numeric keyboard entry than alphabetic character entry ... Therefore, according to the present invention, a different keycode set may be adaptively selected for use with the spreadsheet application"* (column 6, lines 8-17).
14. **Regarding independent claim 9**, the claim is directed toward a computer product for the method of claim 1 and is rejected with the same rationale. Claim 9 further claims a limitation directed toward Spreadsheets. Barile recites: *"Therefore, according to the present invention, a different keycode set may be adaptively selected for use with the spreadsheet application"* (column 6, lines 15-18).
15. **Regarding dependent claim 10**, the claim is directed toward a computer product for the method of claim 2, and is rejected with the same rationale.
16. **Regarding dependent claim 11**, the claim is directed toward a computer product for the method of claim 3, and is rejected with the same rationale.
17. **Regarding dependent claims 13 and 14**, the claims are directed toward a computer product for the method of claims 5 and 6, and are rejected with the same rationale.
18. **Regarding dependent claims 8 and 16**, the claims are rejected for fully incorporating the deficiencies of the base claims

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

20. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barile in view of Bukszar et al. US Patent 6,133,916 (filed 4/8/1998, patented 10/17/2000). "*Bukszar et al.*" is hereafter referred to as "*Bukszar*".

21. **Regarding dependent claim 4**, Barile discloses determining a subset of functions as described above. Barile fails to disclose displaying the subset of functions as a list. Bukszar teaches displaying functions as a list. Bukszar recites: "*Alternatively, various functions can be accessed by clicking a mouse button while the mouse pointer is in the vicinity of a graphical representation 46A-E to display a list of functions applicable to the display of the graphical representation*" (column 4, line 64 to column 5, line 1).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine displaying a list of functions, as taught by Bukszar,

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to the subset of function determination of Barile to provide the benefit of allowing system users the ability to see and access the available functions of the system.

22. **Regarding dependent claim 12**, the claim is directed toward a computer product for the method of claim 4 and is rejected with the same rationale.

23. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barile in view of Hoffberg et al. US Patent 5,901,246 (filed 6/6/1995, patented 5/4/1999). "*Hoffberg et al.*" is hereafter referred to as "*Hoffberg*".

24. **Regarding dependent claim 7**, Barile discloses a family of functions as described above. Barile fails to disclose mathematical, trigonometric, statistical, financial or scientific functions. Hoffberg teaches the use of financial and scientific functions. Hoffberg recites: "*if the text and context of the table indicate that this is a financial table, financial options would be initially provided, and standard financial calculation functions immediately made available or performed, in contemplation of their prospective use. Similarly, if the data appears to be scientific, a different set of options would be initially available, and the standard scientific-type calculation functions be made available or performed*" (column 107, lines 33-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the use of financial or scientific functions as taught by Hoffberg with Barile's family of functions in order to allow users the ability to use built in complex functions.

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25. **Regarding dependent claim 15**, the claim is directed toward a computer product for the method of claim 7 and is rejected with the same rationale.

Conclusion

26. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-5,768,539	06-1998	Metz et al.
• US-6,412,008	06-2002	Fields et al.
• US-6,493,743	12-2002	Suzuki, Hideo
• US-6,496,979	12-2002	Chen et al.
• US-6,563,514	05-2003	Samar, Vipin
• US-6,563,913	05-2003	Kaghazian, Leila

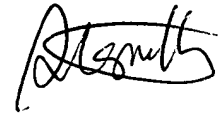
27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
April 2, 2004



STEPHEN S. HONG
PRIMARY EXAMINER